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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/731,854	12/09/2003	Kenneth M. Boy	CT-2709 NP	4249

23914 7590 03/23/2005

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EXAMINER

MORRIS, PATRICIA L

ART UNIT PAPER NUMBER

1625

DATE MAILED: 03/23/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/731,854	Applicant(s) BOY ET AL.	
	Examiner Patricia L. Morris	Art Unit 1625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 January 2005.
 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 3-17 is/are pending in the application.
 4a) Of the above claim(s) 3, 4, 9 and 12-17 is/are withdrawn from consideration.
 5) ☐ Claim(s) _____ is/are allowed.
 6) ☐ Claim(s) _____ is/are rejected.
 7) ☒ Claim(s) 1, 5-8, 10 and 11 is/are objected to.
 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☐ All b) ☐ Some * c) ☐ None of:
 1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
 * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

Claims 1, 5-8, 10 and 11 are under consideration in this application.

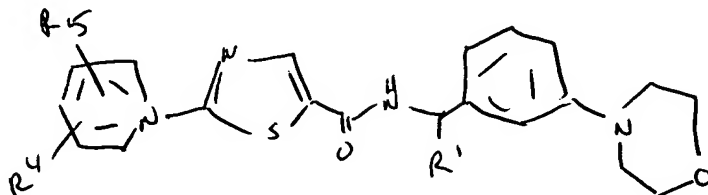
Claims 3, 4, 9 and 12-17 remain held withdrawn from consideration as being drawn to nonelected subject matter 37 CFR 1.142(b).


Election/Restrictions

The requirement is still deemed sound and proper and is therefore maintained for the reasons clearly set forth in the record and is hereby made FINAL. Applicants have already been given the elected species and was expanded to give a reasonable genus. Further, applicants have failed to advance any cogent reasons as to why the compounds are not patentably distinct. Either it is one invention or it is not. Applicants cannot have it both ways. If one were to hold unity of invention, then one reference will be a reference for the **entire** genus.

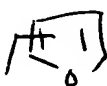

It is too burdensome for the examiner to search all of the previously noted searches in their respective, completely divergent, areas for the non-elected subject matter, as well, in the limited time provided to search one invention.

Again, this application has been examined with regard to the elected compound and expanded to include a genus wherein



R^2 is $-NR^6R^7$ wherein R^6 and R^7 taken with the nitrogen form a morpholine ring, R^4 is halogen, C_{1-6} alkyl, C_{1-6} alkoxy, $-NR^6R^7$, $-(CH_2)_{1-4}NR^6R^7$, $O(CH_2)_{2-3}NR^6R^7$ or , R^6 is

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hydrogen, C₁₋₆alkyl, -C(=NH)NH₂,  or , R⁷ is hydrogen or C₁₋₆alkyl and R⁵ as set forth in Claim 1, exclusively.

Claims 12-17 will NOT be rejoined because they are not readable on the **elected compounds**. Further, claims 12-17 fail to meet the requirements set forth in 35 U.S.C. 101 and 112.

Allowable Subject Matter

Claim 1 is objected to as containing nonelected subject matter. The objection may be overcome by limiting the claim to the subject matter indicated as being examinable, supra. A claim so limited would appear allowable.

Claims 5-8, 10 and 11 presented in independent form or made dependent on an allowable claim, would appear allowable, otherwise it is objected to as being dependent on a nonallowed claim.

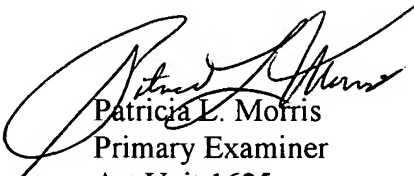
Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patricia L. Morris whose telephone number is (571) 272-0688. The examiner can normally be reached on Mondays through Fridays.

The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Patricia L. Morris
Primary Examiner
Art Unit 1625

plm
March 17, 2005